

AF/2617



RESPONSE UNDER 37 CFR 1.116  
EXPEDITED PROCEDURE  
EXAMINING GROUP 2863  
Docket No.: 1573.1009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Yoshihiro MATSUYAMA, et al.

Serial No. 09/981,982

Group Art Unit: 2617

Confirmation No. 7504

Filed: October 19, 2001

Examiner: TORRES, MARCOS L

For: REMOTE CONTROL OF DOWNLOADING OF CONTENT DATA BY MOBILE DEVICE  
FROM ONE SERVER TO ANOTHER

**REQUEST FOR WITHDRAWAL OF FINALITY AND WITHDRAWAL OF ACTION**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**BOX AF**

Sir:

Applicants respectfully request the Finality of the outstanding Office Action be withdrawn and a new non-Final Office Action be issued in light of the comments below.

In a non-Final Office Action dated June 19, 2006, claims 3 and 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sivula in view of Hicks and further in view of Adachi. The non-Final Office Action notes that "Sivula does not specifically disclose that the ...content data information processing apparatus is different from said first information processing apparatus." However, the Office Action asserts that, and relies on, Adachi to disclose the feature.

Applicants traversed the non-Final Office Action in an amendment filed on September 19, 2006 arguing that neither Hicks, nor Sivula, nor Adachi suggest or disclose the above-mentioned feature.

In a new Final Office Action mailed December 18, 2006, claims 3 and 9 are again rejected under 35 U.S.C. 103(a) as being as being unpatentable over Sivula in view of Adachi. Here the Office Action asserts that Sivula discloses the above-mentioned feature, without attempting to reconcile this assertion with the previous admission that Sivula fails to disclose the

feature. Moreover, the Final Office Action fails to address the Applicant's previous arguments regarding Sivula, Adachi and Hicks, declaring them moot in view of the new ground(s) for rejection.

#### **EXAMINER NOT RESPONDING TO PREVIOUS ARGUMENT**

As noted in at least MPEP 706.07, before a Final Action is proper, a clear issue should be reached between the Examiner and the applicant. As noted in at least MPEP 706.07(f), the Examiner is required to answer and address all traversals. This requirement is in addition to any repetition of a previously held position and is required to allow the applicant a chance to review the Examiner's position as to these arguments and to clarify the record for appeal.

Additionally and as further noted in MPEP 706.07(f), a failure of the Examiner to address the applicant's traversals can be deemed a failure to rebut these arguments so as to admit that the arguments have overcome the rejection. At the very least, the failure to address the applicant's traversals would render the Examiner's decision to again reject the claims arbitrary and capricious and invalid under the Administrative Procedures Act, 5 U.S.C. § 706, the standard under which such rejections are reviewed in view of *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999).

In particular, the Examiner, in asserting the 103(a) rejection based on Sivula in view of Adachi and relying on Sivula to disclose the above-identified features, has not explained why Sivula is now asserted to teach "content data information processing apparatus is different from said processor," when the Examiner has previously acknowledged that it fails do so.

Moreover, the Final Office Action fails to address the Applicant's previous arguments that Sivula, Adachi or Hicks, alone or in combination, fail to suggest or disclose the above-identified features.

As such, since the Examiner has not addressed the Applicants' traversal presented in the Amendment filed on September 19, 2006, and no clear issue has been reached. Accordingly, Applicants request the Examiner withdraw the Final Office Action and issue a new non-Final Office Action addressing the arguments.

CONCLUSION:


As the outstanding Office Action has introduced failed to respond to Applicants' previous arguments, Applicants respectfully submit that the outstanding Office Action is improper. In addition to the withdrawal of finality, applicants further request a new non-final Office Action.

Accordingly, if there are any further formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 3/20/2007

By:   
James J. Livingston  
Registration No. 55,394

1201 New York Ave, N.W., Suite 700  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501